

REMARKS

Applicant appreciates the time taken by the Examiner to review Applicant's present application. This application has been carefully reviewed in light of the Official Action mailed November 1, 2007. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 103

Claims 37, 39-43, 52-59, 69-76, 86-93 and 103-105 stand rejected as being unpatentable under 35 U.S.C. § 103 over U.S. Patent Application Publication No. 2002/0046262 ("Heilig") in view of U.S. Patent No. 6,654,814 ("Britton"). Claims 44-51, 60-68, 77-85 and 94-102 stand rejected as being unpatentable under 35 U.S.C. § 103 over Heilig in view of Britton and further in view of U.S. Patent No. 5,870,734 ("Kao"). The rejections are respectfully traversed. These rejections are nearly the same as the rejections set forth in the previous Office Action mailed May 31, 2007. Thus, arguments submitted in the previous Reply mailed September 25, 2007 remain pertinent and are expressly incorporated herein by reference. The applicability of Heilig, Britton, and Kao to pending claims 37 and 39-105 notwithstanding, as a good faith attempt to expedite the prosecution, independent claims 37, 55, 72, and 89 are amended herein to make explicit that which was implicit.

Additionally, Applicant respectfully submits the following for the examiner's consideration.

Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. *Id.* at 17-18, 148 USPQ at 467. Such evidence, sometimes referred to as "secondary considerations," may include evidence of commercial success, long-felt but unsolved needs, failure of others, and unexpected results.

Of the cited art, Heilig, Britton, and Kao, only Kao appears to be drawn to the architectural deficiency in networked file systems (spelled as "filesystems" in the present application). Kao's solution relies on combining a three-dimensional file system with a specific architecture known as the virtual node (vnode) architecture. See Kao, col. 4, lines 40-62. Kao's solution does not rely on an intermediate device.

Kao's solution appears to be similar to one of the prior attempts to address the problems of unconstrained complexity growth in the networked filesystem environment described in the present application. See Specification, page 8-11, *paras.* 11-16. Specifically, Kao describes

that the “top directory will appear to contain a union of the contents of all of the directories in the Z-stack.” See Kao, col. 5, line 56, through col. 6, line 7; FIG. 1.

At the time of the invention, there remained a long-felt but unsolved need for providing, accessing, maintaining, automating, and controlling networked filesystems and file-based data storage. Even assuming one of ordinary skill in the art at the time the invention was made would somehow have been motivated to combine Heilig, Britton, and Kao, the resulting combination still would not solve the problems of unconstrained complexity growth in the networked filesystem environment. As the Examiner stated on page 6 of the Office Action, the combination of Heilig and Britton may “provide a method to improve the custom-tailoring of client-requested data in order to better exploit the resources available to the clients,” as noted by Britton, col. 3, lines 13-15. Moreover, as the Examiner stated on page 20 of the Office Action, the combination of Heilig, Britton, and Kao may “provide a method for recognition of all mounted file systems for clients,” as noted by Kao, col. 4, lines 18-22. Thus, neither combination provides a system and method for managing a filesystem as set forth in claims 37, 55, 72, and 89.

In responding to Applicant’s previous arguments, the Examiner stated on page 25 of the Office Action that “it is clear that Heileg’s[sic] client system generates a file request (see “client 102*i* preferably sends requests”).” The Examiner further stated that “the aforementioned limitation is entirely broad and as a result, Heilig clearly teaches the broad language of the limitation.” Applicant respectfully disagrees and submits that, within the context of claims 37, 55, 72, and 89, the limitation at issue is not broad at all. Rather, it explicitly recites “generate a first filesystem request.” By contrast, paragraph [0103] of Heilig simply states that the “client 102*i* preferably sends requests to the proxy server.” Heilig does not explicitly teaches “generate” or “filesystem” or “generate a filesystem request”.

According to MPEP 2141, although the prior art reference (or references when combined) need not teach or suggest all the claim limitations, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. According to MPEP 2112, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic

evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). Also, "[a]n invitation to investigate is not an inherent disclosure" where a prior art reference "discloses no more than a broad genus of potential applications of its discoveries." *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1367, 71 USPQ2d 1081, 1091 (Fed. Cir. 2004) (explaining that "[a] prior art reference that discloses a genus still does not inherently disclose all species within that broad category" but must be examined to see if a disclosure of the claimed species has been made or whether the prior art reference merely invites further experimentation to find the species. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Thus, if this rejection is to be maintained in the next Office Action, it is respectfully requested that the Examiner explain why the differences between Heilig and the claim limitation would have been obvious to one of ordinary skill in the art, particularly in view of the fact that Heilig does not seem to be concerned with problems particular to the networked filesystem environment.

As to the Examiner's statement on pages 25 and 29 of the Office Action that the features upon which applicant relies are not recited in the rejected claim(s), Applicant respectfully submits that reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. Here, independent claims 37, 55, 72, and 89 explicitly recite at least the term "filesystem", which is not found in paragraph [0116] of Heilig. Heilig appears to focus on a different type of client-server communication. It seems quite clear from at least paragraph [0113] of Heilig that the request for data as described by Heilig is a request for data and not a filesystem request pertaining to a networked filesystem. Heilig provides a solution to accessing and visualizing data stored at a remote host on a computer network. Nothing in Heilig appears to be applicable to solving the problems particular in a networked filesystem environment.

Like Heilig, Britton appears to focus on data and not on how to manage filesystems. As is known to those skilled in the art, the term "filesystem" refers a high-level abstraction for organizing files and data. See Specification, pages 3-4, *para.* 4. Files are arbitrary containers for data. *Id.* By contrast, Britton describes a client proxy capable of inserting user identity and session identifier in a request for content (data) prior to sending that request to a server proxy. From Britton, it seems quite clear that the request for content thus modified by the client proxy is not a filesystem request. Like Heilig, nothing in Britton appears to be applicable to solving the problems particular in a networked filesystem environment. One reason why data requests such as those described by Heilig and Britton would have had no effect on networked filesystems is that filesystems do not allow arbitrary triggers and associated activities to be programmed outside of the permissions hard coded in the original implementation of the filesystems.

Applicant respectfully submits that one of ordinary skill in the art, at the time the invention was made, could not have combined the elements as claimed in claim 37, 55, 72, and 89 by known methods at least due to technological difficulties in combining Heilig, Britton, and Kao. Additionally, Applicant believes that the elements as claimed in claim 37, 55, 72, and 89 were not known in the prior art at the time of the invention. Thus, one of ordinary skill in the art could not have combined the elements as claimed by known methods with no change in their respective functions. Furthermore, Applicant believes that embodiments as claimed in claim 37, 55, 72, and 89 solve a long-felt but unsolved need in managing networked filesystems.

In view of the foregoing, claim 37, 55, 72, and 89 are submitted to be patentable over the combinations of Heilig, Britton, and Kao 35 U.S.C. § 103 and therefore should be allowed. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, dependent claims 39-54, 56-71, 73-88, and 90-105 are also submitted to be patentable over the combinations of Heilig, Britton, and Kao 35 U.S.C. § 103. Accordingly, withdrawal of this rejection is respectfully requested.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for allowance. Other than as explicitly set forth above, this reply does not include any acquiescence to statements, assertions, assumptions, conclusions, or any combination thereof in the Office Action. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests full allowance of claims 37 and 39-105. The Examiner is invited to telephone the undersigned at the number listed below for prompt action in the event any issues remain.

The Director of the U.S. Patent and Trademark Office is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 50-3183 of Sprinkle IP Law Group.

Respectfully submitted,

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